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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,875	02/16/2000	Toshikazu Nakajima	99USFP421-M.K.	5579

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EXAMINER
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LY, NGHI H

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 09/504,875	<b>Applicant(s)</b> NAKAJIMA, TOSHIKAZU	
	<b>Examiner</b> Nghi H. Ly	<b>Art Unit</b> 2686	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09/12/2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 24 November 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): Claims 22-24 and 27-32.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 23,24 and 28-31.

Claim(s) objected to: 22,27 and 32.

Claim(s) rejected: 20,21,25,26 and 33.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☒ The drawing correction filed on 16 February 2000 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 09/21/2004 have been fully considered but they are not persuasive.

On pages 9 and 10 of Applicant's remarks, Applicant argues that there is no suggestion to combine Valimaa with Jang.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation to do so found in the knowledge generally available to one of ordinary skill in the art in order to minimize the stress on the fingertip since the user does not have to press and hold the key. In addition, claims 20 and 25 do not require the user "only click, but not hold" and claims 20 and 25 merely recite "as soon as the unique identity of the operated one of the plural keys is determined", but fail to specifically disclose "how soon" or "how much time it take". Therefore, the combination of Valimaa and Jang indeed teaches Applicant's claimed limitations with the broadest reasonable interpretation.

For the above reasons, the examiner believes that the rejections to claims 20, 21, 25, 26 and 33 are proper.

***Allowable Subject Matter***

2. Claims 22, 27 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 22 and 27, Valimaa teaches the step operating mode of changing from the call origination mode to an operating mode in which a call cannot be originated occurs when the determined identity of the operated one of the plural numbered dialing keys is one of first set of the plural numbered dialing keys (see column 4, lines 31-41, wherein a long depression of key number 5 recalls the telephone number stored at memory location 5 and see fig.3, step B, wherein long key depression changes from dialing mode to read/write mode).

Valimaa fails to teaches the step of changing from the call origination mode to an operating mode in which a call cannot be originated does not occur when the determined identity of the operated one of the plural numbered dialing keys is one of a second set of the plural numbered dialing keys that does not overlap the first set.

3. Claims 23, 24, 28-31 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Claims 23 and 28 are allowable over the prior art of record for the reasons as stated in Applicant's remarks pages 7-11 (dated 09/21/2004).

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Dependent claims 24 and 29-31 are allowable for the same reason.

***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

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*01/10/05*

*Charles Appiah*  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**